

REMARKS

Applicants respectfully request reconsideration of the application as amended. Claims 1-27 are pending. Claims 1, 4, 5, 16, 17 and 26 are amended. No claims have been cancelled.

I. General Considerations

Applicants note that the following remarks are not intended to be an exhaustive enumeration of the distinctions between any cited references and the claimed invention. Rather, the distinctions identified and discussed below are presented solely by way of example to illustrate some of the differences between the claimed invention and the cited references. In addition, Applicants request that the Examiner carefully review any references discussed below to ensure that Applicants understanding and discussion of the references, if any, is consistent with the Examiner's understanding.

Applicants also note that the remarks presented herein have been made merely to clarify the claimed embodiments from elements purported by the Examiner to be taught by the cited reference. Such remarks, or a lack of remarks, are not intended to constitute, and should not be construed as, an acquiescence, on the part of the Applicants: as to the purported teachings or prior art status of the cited references; as to the characterization of the cited references advanced by the Examiner; or as to any other assertions, allegations or characterizations made by the Examiner at any time in this case. Applicants reserve the right to challenge the purported teaching and prior art status of the cited references at any appropriate time.

II. REJECTIONS MADE BY THE EXAMINER

A. Rejection Under 35 U.S.C. §102

In the present Office Action, claims 1-27 were rejected under 35 U.S.C. 102(b) as being anticipated by Bird et al. (U.S. Patent Number 6,108,438). A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a

single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

In response, Applicants have amended independent claims 1, 16 and 26 to further clarify and distinguish the claims from the cited reference. The dependent claims 4, 5 and 17 are also amended to conform with amendments made to their base claims. As amended, Applicants respectfully assert that Bird et al. does not teaches or discloses each and every limitation set forth in the amended independent claim 1, 16, and 26, since the apparatus and the method as presently claimed is clearly distinct from the finger sensing device as disclosed in Bird et al. As such, the cited reference Bird et al. does not anticipate the amended independent claims 1, 16, and 26 and all the claims should be allowed.

1. Patentability of Amended Independent Claim 1

The amended independent claim 1 recites in part: “a conductive structure adjacent to the pixel array coupled insulator, the conductive structure exposed for physical contact with a second contacting portion of the hand; and a first signal generator coupled to the conductive structure, wherein the first signal generator is operable to drive a charge through the second contacting portion to the first contacting portion of the hand.”

Bird et al. teaches a finger sensing device having strips of conductive material on the upper surface of the insulating layer (Column 9, Lines 52-55), which also contains a sense element array having a pulse generating circuit to generate a selection-signal to select a particular row of sense element in the form of voltage pulse to the row conductors (Column 6, Lines 39-42), and another -pulse generating circuit to drive-generate a signal to read the charge stored in the associated column conductor (Column 6, Lines 42-57). The row and column pulse generating circuit's function is further evidenced by a detail explanation of schemes to detecting inputs from rows of sense elements and reading the signals stored in each column of sense elements (Column 6, Line 58 – Column 9, Line 46). In contrast, the amended claim 1 is distinguishable from the cited references in several ways.

First, the finger sensing device in Bird et al. describes having strips of conductive materials ~~are~~ provided directly on the upper surface of the insulating layer and in contact with the finger (Column 6, Lines 6-10). The apparatus described in amended claim 1 is fundamentally different. The strips of conductive materials and the insulating layer in Bird et al. are integrated together, whereas the “conductive structure” and “the pixel array coupled insulator” in amended claim 1 are separate but adjacent physical structures. The fact that “conductive structure” and “the pixel array coupled insulator” are separate but adjacent physical structures is further evidenced in the claim where the insulator is in physical contact with the first portion of the hand and the conductive structure is in physical contact with the second portion of the hand. In contrast, Bird et al. teaches a finger in physical with both the strips of conductive material and the insulating layer since the conductive material is directly on top of the insulating ~~layer~~.

Second, the strips of conductive materials in Bird et al. ~~are to~~ provide grounding (Column 9, Lines 57-58). Assuming *arguendo* that the strips of conductive materials in Bird et al. correspond to the “conductive structure” in amended claim 1, they are functionally different where the “conductive structure” in the amended claim 1 is “coupled” with “a first signal generator” to ~~provide~~ “drive(n)g” a charge through the second contacting portion to the first contacting portion of the hand.” The conductive materials in Bird et al. are not used to “drive a charge” and therefore are distinguishable from the amended claim 1.

Third, the pulses generated by the pulse generating circuits in Bird et al. are limited to selecting rows and columns of the sensing array below the insulating layer (Column 6, Lines 36-50), and thus any potential or pulse generated are limited to the circuits below the insulating layer and insulated from any body part that are in contact with the insulating layer. In contrast, the “charge” in the amended claim 1 is “drive(n) through the second contacting portion of the hand to the first contacting portion of the hand,” which is clearly distinguishable. For the foregoing reasons, Applicant respectfully submits that the Examiner has failed to establish that the amended independent claim 1 is anticipated by Bird et al. because the Examiner has not established that each and every element as set forth in claim 1 is found in Bird et al. The rejection to the amended independent claim 1 should be withdrawn.

2. Patentability of Independent Claim 16 and 26

The amended independent claim 16 recites a method which comprises “driving a first charge from a conductive structure adjacent to the pixel array, through a portion of a hand in contact with the conductive structure and the finger, into at least one of the plurality of storage capacitors.”

In the Office Action, the Examiner alleges that Figs. 3 and 7 and Column 10 Lines 10-35 in Bird et al. correspond to the method described in the independent claim 16. In response, Applicants amended the independent claim 16 to clarify and to further distinguish the claim from the cited reference. Bird et al. describes applying pulse signals to row and column conductors (Column 10, Lines 28-35), and based on the finger sensing device described, the pulse signals are applied to the sensing array below the insulating layer thus insulated from the finger that is in physical contact with the insulating layer. As amended, the independent claim 16 is distinct from Bird et al. since in the amended claim 16, “a first charge” is driven from “a conductive structure adjacent to the pixel array, through a portion of a hand in contact with the conductive structure and the finger, into at least one of the plurality of storage capacitors,” whereas in Bird et al. the pulse ~~is not applied~~did not go through the user’s finger as described in the amended claim. As such, Applicants respectfully submit that the Examiner has failed to establish that the amended independent claim 16 is anticipated by Bird et al. because the Examiner has not established that each and every element as set forth in claim 16 is found in Bird et al. The rejection to the amended independent claim 16 should be withdrawn.

The amended independent claim 26 recites an apparatus comprising “means for driving a first charge from a conductive structure adjacent to the pixel array through a portion of a hand in contact with the conductive structure, through the finger, into a first contact of at least one of the plurality of storage capacitors.” As amended, the independent claim 26 contains the similar limitation as in the amended independent claim 16. As such, the amended independent claim 26 is also not anticipated by Bird et al. as the above remarks have concluded, and should be allowed as least for the same reason as the amended independent claim 16.

3. Patentability of the Dependent Claims Associated with Amended Independent Claims 1, 16, and 26

The dependent claims 2-15, 17-25 and 27 were rejected under 35 U.S.C. 102(b) as being anticipated by Bird et al. Applicants have amended dependent claims 4, 5 and 17 to conform with amendments made to their base claims. Since the dependent claims 2-15, 17-25 and 27 depend on the amended independent claims 1, 16, and 26, each dependent claim includes all the limitations of the respective base claim. If the respective base claim is allowable as concluded by the remarks above, these dependent claims also are not anticipated by the cited references as alleged in the Office Action. For the foregoing reason, Applicant respectfully submits that the dependent claims 2-15, 17-25 and 27 should be allowed for at least the same reasons that their respective base independent claims 1, 16, and 26 are allowable.

B. Conclusion

In view of foregoing, Applicants respectfully submit that each of the pending claims 1-27 is in condition for allowance. Therefore, reconsideration of the rejection is requested and allowance of these claims is earnestly solicited. In the event that the Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, or which may be overcome by an Examiner's Amendment, the Examiner is requested to contact the undersigned attorney.

If there are any additional charges, please charge Deposit Account No. 02-2666 for any fee deficiency that may be due.

Respectfully submitted,

BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP

Date: June 16, 2008

By: /Michael J. Mallie/

Michael J. Mallie

Reg. No. 36,591

1279 Oakmead Parkway
Sunnyvale, California 94085-4040
(408) 720-8300